UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,122	12/31/2003	David Eli Wexelblat	06975-460001	1740

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EXAMINER
PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/31/03*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12/31/02* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>6/04 & 6/05</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to Application No. 10/748,122 filed 12/31/03, claims 1-42 have been examined.

Claim Objection

2.   Claim 13 recites the limitation " the out-of-band communication" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejection under 35 U.S.C §103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Pickup (US 2003/0212791) in view of Brown et. al. (US 2002/0078158) (Brown hereafter)

Regarding claim 1, Pickup teaches a sender sends communication to the recipient Fig. 2 and sending to a recipient said communication (Fig. 2);

said communication intended to a recipient contains information identifying a sender, e.g. a sender address [0003];

determining whether said information identifying said sender of said communication appears in a list associated with said recipient, and identifying in response to said determination that said sender does not appear in said list associated with said recipient [0024, 0037];

in response to identifying that said sender does not appear in said list associated with said recipient, forwarding a request for verification [0025-0026];

adding the information identifying the sender to said list in response to a received verification from the sender in response to said identifying that the sender does not appear in said list [0026, 0040, 0058], however Pickup does not explicitly disclose a first communication channel distinct from a second communication channel through which recipient receives a communication;

Brown discloses an email server for storing messages for viewing upon client's request [006], including

sending by a sender (12 of Fig. 1) a communication to an intended recipient over a first communication outbound channel (22 of Fig. 1) and receiving communication over a second inbound channel (35 of Fig. 1) distinct from the first (abstract), and

sending by a sender (312 of Fig. 4) a communication to an intended recipient over a first communication outbound channel coupled to a network, said first communication channel is another channel than the channel through which the communication was received from intended recipient (342 of Fig. 4) coupled to said network;

wherein the communication (correspondence) contains an email address [0006], wherein an outbound email message intended to a recipient comprises a destination address and information regarding the intended recipient [0079], having "to" and "from" fields [0129].

It would have been obvious to one of ordinary skilled in the art at the time the invention was made given the suggestion of Pickup for communicating email between users, the teachings of Brown for communicating media enhanced emails between users, would be readily apparent. One of ordinary skill pertaining e-mails or electronic messaging systems would recognize, that once a sender sends an e-mail message to an intended recipient (i.e. recipients email address), the intended recipient at client terminal, performs the action of logging on to a corresponding email server for accessing his/her e-mail, and thereby the recipient is able to read any e-mail messages that might have been addressed to him or her at that e-mail address. One would be motivated to combine these teachings because in doing so email can be enhanced with multimedia content with out requiring a separate application operable with standard email servers.

5.   Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickup in view of Brown in further view of JUDGE (US 2003/0172294)

Regarding claim 2, however the above-mentioned prior art do not explicitly teach deleting identifying information for the sender from the white list associated with a recipient after an elapsed period of time.

JUDGE teaches a triggering deletion of the identifying information for the expected communications sender from the white list associated with the intended communications recipient at a predetermined time [0166]. Additionally, teaching determining regarding received/out-of-band communication [0051] whether the identifying information for the expected communications sender appears in a white-list associated with the intended communications recipient [par 0033; 0048, 0057, and

Fig. 10] and adding the identifying information for the expected communications sender to the white-list associated with the intended communications recipient in response to a determination that the identifying information for the expected communications sender does not appear in the white-list associated with the intended communications recipient [see par 0057, 0102, 0162, 0183 and Fig. 10]; including adding automatically identifying information from the sender to a whitelist [0174], including

sending a communication to an intended recipient over a first communication outbound channel and receiving communication over a second inbound channel distinct from the first [0131-0132].

It would have been obvious at the time the invention was made given the teachings for preventing the reception/transmission of email to unauthorized senders the teachings of JUDGE for detecting and preventing the delivery of unsolicited email communication would be readily apparent. One ordinary skilled in the art would be motivated to receive an electronic communication directed to or originating from an email server (that is, for example in response to an action by a sender who send a communication to an email server or in response to an action by a recipient who is accessing a communication from an email server), testing (determining) the received communication to compare the sender's identifying information, e.g. address in the received communication to addresses contained in one or more white-list [see par. 0048], as taught by JUDGE to prevent a recipient from receiving unsolicited email.

Regarding claims 3-5, the identifying information for the expected communications sender is an e-mail address for the expected communications sender [Pickup: 0011, 0013]; and an IP address [Brown :0189].

Regarding claim 6, determining whether recipient appears in a white-list associated with the expected communications sender; and adding the identifying information for the intended communications recipient if said recipient does not appear in the white-list associated with the expected communications sender [Pickup: 0026, 0040, 0058].

Regarding claims 7-8, upon receipt of a communication from the expected communications sender, triggering the sending of the communication to the intended communications recipient, wherein the received communication is one of an email message [Pickup: 0026, 0040]; email, instant message and phone call [Judge: 0055]

Regarding claims 9-12, upon sending the communication to the intended communications recipient, triggering deletion of the identifying information for the expected communications sender from the

white-list associated with the intended communications recipient [Judge: 0166]; email, instant message and phone call [Judge: 0055]

6.   Claims 13-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickup-Brown in view of Duvall et. al. (US 5,884,033) (Duvall hereafter) in further view of Paul (US 5,999,932).

Regarding claim 13, comprising limitation similar to those applied on claim 1, same rationale of rejection is applicable.

receiving a communication from a service provider over a said communication channel [Pickup: 0061];

determining whether said information identifying said sender of said communication appears in a list associated with said recipient, and identifying in response to said determination that said sender does not appear in said list associated with said recipient [Pickup: 0024, 0037]; however the above mentioned prior art does not teach determining if a host has a list used for filtering email.

Duvall in the same field of applicant's endeavor teaches filtering incoming or outgoing messages using stored filters comprising listing associated with a predetermined action to be applied to the said incoming or outgoing messages (col 4/lines 23-37). Specifically,

determining if a host has a list used for filtering email, by searching a database for filters based on the incoming or outgoing message, said database containing a list of filters (col 4/lines 38-55) and

Email-filtering list having entries containing expiration date, frequency of update, and identification of the filter set (col 7/lines 41-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestions of Pickup for filtering inbound and outbound email the teachings of Duvall for filtering email by determining whether to block or allow incoming and/or outgoing messages using a filter database having a list of filters software implemented on the client or server system and further applicable to firewall, gateways or proxy servers, as taught by Duvall. One of ordinary skill given the suggestions of Duvall for maintaining an expiration data associated with said filtering list entries as means for updating and/or purging respective entries in the filter list. Entries are examined to determine if the expiration date/time been reached when compared with the current date/time or alternatively, the expiration date/time may represent a "time to keep" value stored in respective entry using a creation or received date with which to compare, regardless of the detection mechanism upon determining that the entry is stale, the entry is either updated or purged. One would be motivated to apply theses teachings to the Pickup system because in doing so different specified blocking options, including discarding incoming and/or

outgoing message can be applied using various portions of the email other than addresses, as suggested by Duvall. However, the above-mentioned prior art does not teach where the adding is performed automatically.

Paul teachings in the same field of applicant's endeavor teaches automatically adding information identifying the sender from a communication received from a service provider to a list (US 5,999,932 Paul: col 5/line 5-17, col 6/lines 20-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestions of Pickup for filtering inbound and outbound email the teachings Paul would have been readily apparent. One of ordinary skilled in the art would be motivated to apply the teachings of Paul for automatically updated inclusion list, to overcome the drawback of the prior which require manual update, Paul teaches using e-mail messages received from sources other than those on the automatically updated inclusion list, thus, making it possible to eliminate virtually all of unsolicited e-mail messages and is not vulnerable to changes in the unsolicited e-mail origin addresses.

Regarding claim 14-15, automatically adding information identifying the expected e-mail sender and a transactional identifier to the white-list includes adding a indicator which permits handling of mail (e.g. an identifier or address [Pickup: 0026, 0040, 0058 and Judge: 0174].

Regarding claim 16, this method claims comprises substantially the same method steps/acts as those discussed on claims 1-2, 6, 13 and 15 discussed above, same rationale of rejection is applicable. Further including importing a whitelist from a third party service provider [Judge: 0036, 0146-0148].

Regarding claim 17, this claims comprises limitations substantially the same as those discussed on claim 14, same rationale of rejection is applicable.

Regarding claim 18, this comprises substantially the same limitation(s) discussed on claim 14, same rationale of rejection is applicable.

Regarding claims 19-26, time stamp means for performing expiration time [Judge: 0166, 0208].

Regarding claims 27-28, corporation's local network [Judge: 0023], RPC [Judge: 0182].

Regarding claim 29, substantially the same as claims 1, 13 and 16, where a gateway received emails from a service provider [Judge: Fig. 1, external providers 170, to local clients 130 through firewall, i.e. gateway 140].

Regarding 30, users explicitly list users from whom email is desired [0036].

Regarding claim 31, substantially the same as claims 1, 13 and 16, claimed term "temporarily permit", given the broadest reasonable interpretation reads on permitting, thereby, whitelist, inclusion or allow list and blacklist, exclusion or reject list of the prior art are equally applicable.

Regarding claim 32, this claim is substantially the same as claims 1, 13 and 16 and rationale set forth thereon, comprising combined whitelist and blacklist filtering.

Regarding claim 33-35, these claims are substantially the same as claims 1-2, 11 and 13-14, same rationale of rejection is applicable.

Regarding claims 36-37, these claims are substantially the same as claim 8, same rationale of rejection is applicable.

Regarding claim 38, this claim is substantially the same as claims 1, 13 and 16, same rationale of rejection is applicable.

Regarding claims 39-40, whitelist is maintained on a local device such as personal computer [Judge: 0036].

Regarding claims 41-42, these claims comprise limitation substantially the same as those discussed on claims 1-2, 13, 16, where the whitelist thereon is the same as the "list of approved senders" hereon and the service provider thereon is the same as the "authorized source" hereon, same rationale of rejection is applicable

Citation of Pertinent Art:

7.   The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Copies of Non-Patent Literature documents cited will be provided as set forth in MPEP§ 707.05(a):

(US 6,249,805)

Fleming teaches a component configured to scan previously sent electronic mail messages and add the identifications of the recipients to the authorized sender list. The authorization component can also scan previously received electronic messages (e.g., in a certain folder) and add the identifications of the senders to the authorized sender list. In addition, the authorization component can automatically add the identification of each recipient to the authorized sender list whenever the user sends an electronic mail message.

(US 5,987,508)

Agraharam et. at. discusses as prior art that in order for the user at client terminal to send an e-mail message to an intended recipient at client terminal, the sender must know recipient's complete e-mail address including the precise domain name of e-mail server and the precise name by which that server knows the recipient. Once a sender sends an e-mail message to that address, the intended recipient at client terminal 102, when logging on and accessing e-mail server, is able to read any e-mail messages that might have been addressed to him or her at that e-mail address. Thereby teaching claimed limitation "in response to an action by an intended communications recipient, receiving an out-of-band communication from a service provider".

(US 6,529,943)

Ohi teaches where a mail server upon receiving a mail for an intended recipient, the mail server places the mail in a spool for the receiver. When the receiver uses, for example, the POP3 protocol to access the mail server in order to check the received mail, the mail server obtains the mail from the spool to transmit it to the receiver's client machine.

(US 5,944,786)

Quinn teaches an e-mail server is located remote of the computer system, at an Internet service provider, or other e-mail service provider's location. A recipient computer may then communicate with

the e-mail server and retrieve the e-mail from the recipient addressed mailbox, i.e. where the e-mail message is stored in a recipient's mailbox which has a recipient identifier code associated with it.

(US 4,425,665)

Stauffer discloses where the typical operation of a modem includes two external terminals, where only one transmit channel and one receive channel are employed internally. In normal half duplex operation, a modem is either transmitting on the main channel or receiving on the back channel or vice versa. In full duplex operation, the state machine configures the transmitter 18 and receiver 20 for receiving or transmitting data simultaneously.

(US 6,052,709)

Paul teaches a service provider may prevent users from receiving e-mails from specific sources or e-mail messages including certain subject matter (e.g., pornographic subject matter) by adding source data and/or subject data to the filtering application exclusion lists. The network users may or may not be given authorization to access or change the exclusion list data entered by the system operator. Service provider entries in the exclusion list may or may not be displayed to the users.

(US 6,546,416)

Kirsch where new messages prepared by the e-mail user of the system 14, and ordinary reply and forward massages are considered original. The destination e-mail address specified in an original message is then matched 126 against the accept list 24 to determine whether the address has already been recorded. If not, the recipient e-mail address is added 128 to the accept list 24.

(US 6,336,117)

Massarani teaches determining if a white list is present, the search engine searches only web sites or root content sources that match the explicit allowable site/URL list or white list.

WebGuard: Web Based Adult Content Detection and Filtering System, Hammami, M., et. al.
Proceedings of the IEEE/WIC International Conference on Web Intelligence (WI'03)
0-7695-1932-6/03

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see http://pair-direct.uspto.gov or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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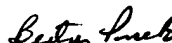Hand carried or delivered to:
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TC 2100
December 8, 2005

BEATRIZ PRIETO
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